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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/036,053 03/06/98 EPPSTEIN

J 19141.0001

QM12/1015

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EXAMINER

BOCKELMAN, M

ART UNIT

PAPER NUMBER

3763

DATE MAILED:

10/15/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/036,053

Applicant(s)

Eppstein

Examiner

Bockelman

Group Art Unit

3763

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on 7-21-99
- ☐ This action is FINAL.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-21, 29, 32-45 is/are pending in the application.
Of the above claim(s) 32-43 is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) ~~1-21, 29~~, 1-15, 17-18, 21 is/are rejected.
- ☒ Claim(s) 16, 19-20 and 44 is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
 - ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
 - ☐ received in Application No. (Series Code/Serial Number) _____
 - ☐ received in this national stage application from the International Bureau (PCT Rule 1 7.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 4
- ☐ Interview Summary, PTO-413
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other _____

Office Action Summary

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DETAILED ACTION

Election/Restriction

1. Claims 32-43 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b) as being drawn to a non-elected invention III. Election was made **without** traverse in Paper No.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

3. Claims 1-3, 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Gerstel et al 3,964,482.

Gerstel teaches a device that microporates the skin using probes 12 , flux enhancers 48-64 and diuretics (column 14 line 9) as one of the many drugs.

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4. Claims 1, 3, 8-9, 13, 17-18, 21, 29, 45 are rejected under 35 U.S.C. 102(e) as being anticipated by Johnson et al USPN 5,947,921.

Johnson teaches the mixing of electroporation, ultrasound and flux enhancers to both deliver drugs as well as extract analytes which can also include suction (column 9 line 1-11) as well as inflammatory mediators in the form of corticosteroids.

5. Claims 1 and 7 are rejected under 35 U.S.C. 102(e) as being anticipated by Ammonia Amplifies Nicotine, Study Confirms by John Schwartz..

The examiner considers the alveoli I the lungs which absorbs both ammonia and Nicotine to be micropores.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 2, 10-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson et al. USPN 5,947,921 in view of Gerstel USPN 3,964,482 and Lee et al USPN 5,250,023.

Applicant differs from Johnson et al. in reciting a probe that is heated to carry the flux enhancer.

Gerstel shows that it was known to deliver flux enhancers as carried by microprobes 12 to help

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penetrate the stratum corneum. To have provided the Johnson et al device with such structure for similar reasons would have been obvious. Without specifying a datum point, all probes are considered heated.

8. Claims 4-6, 14-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson et al USPN 5,947,923 in view of Bettinger USPN 5,427,585.


Applicant differs from Johnson in providing a heating element to heat the treatment site. Bettinger shows such a device to pretreat the skin for enhanced delivery. To have provided Johnson with the heating device of Bettinger for similar reasons would have been obvious. It is noted that the ethanol that Johnson et al uses is known to vaporize at room temperature. The added heat from resistance heating would cause even faster vaporization.

Allowable Subject Matter

9. Claims 16, 19-20 and 44 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark Bockelman whose telephone number is (703) 308-2112. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Wood-Coggins, can be reached at (703) 308-1344. The main fax phone number for this Group is (703) 305-3590. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0858.


MARK BOCKELMAN
PRIMARY EXAMINER

MWB

October 12, 1999